

Notice of Allowability	Application No.	Applicant(s)	
	09/373,018	NASH ET AL.	
	Examiner	Art Unit	
	Marjorie A. Moran	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/11/03.
 2. ☒ The allowed claim(s) is/are 16-22,54-63 and 73-76.
 3. ☒ The drawings filed on 25 November 2002 are accepted by the Examiner.
 4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
 6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>attached</u> |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____ | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Rejoinder

Claims 16-22 are directed to an allowable method. Claims 54-63, which depend from the allowed claims, and were previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 54-63 are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Claims 16-22, 54-63, and 73-76 are pending.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Jeff Hsi on September 21, 2003.

The application has been amended as follows:

Please replace claims 54 and 61-63 with the following:

54. The method of claim 16, further comprising the steps:
- (f) contacting a second biomolecule with the mass-coded combinatorial

library, whereby members of the mass-coded combinatorial library which are ligands for the second biomolecule bind to the second biomolecule to form second biomolecule-ligand complexes;

(g) separating the second biomolecule-ligand complexes from the unbound members of the mass-coded combinatorial library;

(h) dissociating the second biomolecule-ligand complexes;

(i) determining file molecular mass of each ligand for the second biomolecule; and

(j) determining which molecular mass or masses determined in step (e) are not determined in step (j), thereby providing the molecular masses of members of the mass coded combinatorial library which are ligands for the first biomolecule but are not ligands for the second biomolecule;

wherein each molecular mass determined in step (i) corresponds to a set of n peripheral moieties present in a ligand for the first biomolecule which is not a ligand for the second biomolecule, thereby identifying members of the mass-coded combinatorial library which are ligands for the first biomolecule but are not ligands for the second biomolecule.

61. The method of Claim 60 wherein the solid support is a water-insoluble matrix contained within the chromatographic column.

62. The method of Claim 55, wherein one or both of steps (c) and (g) is performed by contacting a solution comprising first biomolecule-ligand complexes or second biomolecule-ligand complexes and unbound members of the mass-coded combinatorial library with a size exclusion chromatography column, whereby the unbound members of the mass-coded combinatorial library elute from the column after the first biomolecule-ligand complexes or the second biomolecule-ligand complexes.

63. The method of claim 55, wherein one or both of steps (c) and (g) is performed by contacting a solution comprising first biomolecule-ligand complexes or second biomolecule-ligand complexes and unbound members of the mass-coded combinatorial library with a size exclusion membrane, whereby the members of the mass-coded combinatorial library pass through said membrane and the first biomolecule-ligand complexes or second biomolecule-ligand complexes do not pass through said membrane.

Allowable Subject Matter

Claims 16-22, 54-63, and 73-76 are allowed for reasons of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3524.

MARJORIE MORAN
PATENT EXAMINER

Marjorie A. Moran

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